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REMARKS

Claims 1 – 20 remain in the application and stand finally rejected. A proposed amendment to claims 9, 19 and 20 is offered. No new matter has been added.

The specification is objected to under 35 U.S.C. §132(a), asserting that the amendment to the specification introduces new matter. While the applicants believe that it would be understood by a person of ordinary skill in the art that the plug-ins were locating and removing the unseen markers recited in claims 4 and 12, there is nothing that requires that it be the plug-ins. Accordingly, paragraph 14 is amended herein. No new matter is added. Reconsideration and withdrawal of the objection to the specification under 35 U.S.C. §132(a) is respectfully requested.

A proposed amendment is offered amended to amend claims 9, 19 and 20 grammatically. No new matter is added.

Claims 4 and 12 have not yet been substantively rejected. However, claims 4 and 12 are finally rejected under 35 U.S.C. §112 “as failing to comply with the enablement requirement [because] the claim(s) contains subject matter which [it is alleged] was not described” to enable one skilled in the art to make and use the invention. The applicants note that

Some latitude in the manner of expression and the aptness of terms **should** be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but **should not reject claims or insist on their own preferences** if other modes of expression selected by applicants satisfy the statutory requirement.

MPEP 2173.02 (emphasis added.) However, responding to the applicants’ previous assertion that, a skilled artisan, knowing that the unseen markers will remain after deleting the visual cues, would know how to locate them; the final Office action avers that, “Deleting visual cues object [sic] would result in also deleting the unseen marker.

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Therefore, the unseen marker would not remain after deletion." There is nothing in the specification to require deleting the unseen markers with visual cues and no basis in any reference of record to support such a requirement.

In the prior Office action, the applicants averred that "a skilled artisan would understand how to embed hidden markers in files (e.g., MSWord allows one to hide formatting marks), clearly, the specification enables "inserting an unseen marker" as claims 4 and 12 recite." In further support of this contention, the applicants note, for example, that "[m]etadata are structured, encoded data that describe characteristics of information-bearing entities to aid in the identification, discovery, assessment, and management of the described entities." (Committee on Cataloging Task Force on metadata Summary Report, www.libraries.psu.edu/tas/jca/ccda/tf-meta3.html, 1999). MSWord documents are notoriously known to contain hidden metadata. For example, Brian D. Zall in "Metadata: Hidden Information in Microsoft Word Documents and Its Ethical Implications" *Colorado Lawyer* Oct. 2004 ed. (www.sah.com/documents/attorneys/769_20041004_colorado_lawyer.pdf), teaches that "an electronic trail is created whenever a user creates, edits, and saves a document in most word processing, spreadsheet, or other computer programs.¹ Such document is likely to contain a treasure trove of accessible hidden information known as 'metadata.'² (footnotes original)." The second Zall footnote refers to "Office 2003/XP Add-in: Remove Hidden Data" located on the Microsoft website. (None of the Summary Report, Zall or the Microsoft web site are being presented as references affecting patentability, but are proffered as extrinsic evidence regarding the knowledge of the existence of unseen document features. Accordingly, an Information Disclosure Statement is not believed necessary.) Therefore, for the metadata example, very clearly, "Deleting visual cues object [sic] would [not necessarily] result in also deleting the unseen marker." Moreover, absent some steps to remove them, "the unseen marker would ... remain after deletion." Furthermore, it is apparent that a skilled artisan, knowing that the unseen markers will remain after deleting the visual cues, would know how to locate them.

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Accordingly, the specification, as filed and as amended, clearly supports and enables the present invention as recited in claims 4 and 12. Reconsideration and withdrawal of the rejection of claims 4 and 12 under 35 U.S.C. §112 for lack of enablement is respectfully requested.

Claims 1, 3 – 5, 9 and 11 – 13 are finally rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,614,454 to Livingston. Claims 2 and 10 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Livingston in view of U.S. Patent No. 6,880,124 to Moore. Claims 6 – 8 and 14 – 16 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Livingston in view of published U.S. Patent Application No. 2002/0184305 to Simpson et al. Claims 17 and 19 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Livingston in view of U.S. Patent No. 6,268,924 to Koppolu et al.

Responding to the applicants' previous assertion that Livingston does not teach or suggest creating an amended document; it is asserted that "According to the definition within the art, a document is a writing that contains information. **The print preview image is therefore a document.** When the print preview image is changed by placing visual cues in the document, an amended document is created. (emphasis added)." The MPEP, §2111, entitled, "Claim Interpretation; Broadest Reasonable Interpretation" provides in pertinent part "CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION During patent examination, the pending claims must be 'given *>their< broadest reasonable interpretation consistent with the specification.' >In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)" (emphasis added). That "broadest reasonable interpretation of the claims **must also be consistent** with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)." *Id.* (emphasis added). The Applicants aver that it is an unreasonable interpretation and inconsistent with the specification to hold that the "**print preview image is ... a document.**"

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Furthermore, it is apparent that for the first time, the final Office action is taking Official Notice that **"print preview image is ... a document."** §2144.03 of the MPEP entitled, "Reliance on Common Knowledge in the Art or 'Well Known'" requires that "C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence." The applicants hereby challenge the assertion that **"print preview image is ... a document"** as being "Not Properly Officially Noticed [and] not Properly Based Upon Common Knowledge," as required by §2144.03. Therefore, to maintain the final rejection "the Examiner Must Support the Finding With Adequate Evidence." *Id.* None has yet been provided.

As previously noted, claim 1 clearly recites "creating an amended document" [not an amended image] at line 4 and, thereafter, operates on the amended document. *See also*, claim 9, lines 8 – 9. Nowhere does Livingston teach "an amended document" as claims 1 and 9 recite that is "consistent with the specification," as required; *supra*. In particular, claim 1 recites at lines 5 – 8, that the amended document includes visual queues (and unseen markers or attendant list). *See also*, claim 9, lines 9 – 12. So, while the visual cues included in the amended document may represent print controls, the visual cues are not provided to the printer. *Id.* Instead, they are part of the amended document until they are removed "from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects and performing the specific operations." Claim 1, *supra*. Thus, "dog-ear corners are very useful when editing the job ticket in the application, but are not desirable in the printed output document. The job ticket parameters represented by the visual cues are stored or printed **via the job ticket instead.**" (emphasis added). This "amended document" is quite different than the Livingston image, and the present invention operates quite differently, than the Livingston GUI.

Accordingly, because Livingston does not teach inserting visual cues into an original document to create an amended document "consistent with the specification,

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(*supra*),” and removing the visual cues from the amended document as claims 1 and 9 recite; Livingston fails to perform “the identical function specified in the claim [1 or 9] in substantially the same way, and [fails to produce] substantially the same results.” MPEP, §2131. Furthermore, the rejection under 35 U.S.C. §102(e) over Livingston is based on facts “Not Properly Officially Noticed [and] not Properly Based Upon Common Knowledge,” as required by §2144.03. Thus, the applicants have met their burden in overcoming the allegation of *prima facie* anticipation based on direct anticipation; or, by an alleged equivalency that is inconsistent with the specification, i.e., that the “**print preview image is ... a document.**” Therefore, since the present invention, as recited in claims 1, 3 – 5, 9 and 11 – 13 is quite different and operates quite differently than the Livingston GUI; Livingston does not teach the present invention or an equivalent thereof, and so, does not anticipate the present invention. Reconsideration and withdrawal of the final rejection of claims 1, 3 – 5, 9 and 11 – 13 under 35 U.S.C. §102(e) over Livingston is respectfully requested.

Regarding the final rejection of claims 2 and 10 under 35 U.S.C. §103(a) over Livingston in view of Moore; Moore is cited because “Moore discloses automatically saving a document when printing (col. 7, lines 12-18).” As previously noted, Moore does not provide anything to teach or suggest creating an amended document “consistent with the specification, (*supra*),” which was missing from Livingston, to result in the present invention as recited in claims 1 or 9, much less claims 2 and 10 depending therefrom. Accordingly, since dependent claims include all of the differences with the references as the claims from which they depend, Moore in combination with Livingston does not result in the present invention as recited in claims 2 and 10. Reconsideration and withdrawal of the final rejection of claims 2 and 10 under 35 U.S.C. §103(a) over Moore in combination with Livingston is respectfully requested.

Regarding the final rejection of claims 6 – 8 and 14 – 16 under 35 U.S.C. §103(a) as being unpatentable over Livingston in view of Simpson et al., it is asserted that “Simpson et al. disclose plug-in [sic] to a document editor providing a plug-in interface

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(page 1, paragraph 3).” However, as previously noted, neither does Simpson et al. provide anything to teach or suggest creating an amended document “consistent with the specification, (*supra*),” substantially as recited in the claims, which was missing from Livingston, to result in the present invention as recited in claims 1 or 9, much less, claims 6 – 8 and 14 – 16 depending therefrom. Since dependent claims include all of the differences with the references as the claims from which they depend, neither the combination Simpson et al. with Livingston, alone or, in further combination with either Moore or any reference of record, results in the present invention as recited in claims 6 – 8 or 14 – 16. Reconsideration and withdrawal of the final rejection of claims 6 – 8 and 14 – 16 under 35 U.S.C. §103(a) over the combination Simpson et al. with Livingston is respectfully requested.

Regarding the final rejection of claims 17 – 20 under 35 U.S.C. §103(a) over Livingston in view of Koppolu et al. alone or further in combination with Simpson et al.; Koppolu et al. is cited to teach “a print preview being a thumbnail.” Leaving aside whether “display a ‘thumbnail’ graphic of the document” as Koppolu et al. recites at col. 6, lines 36 – 37, teaches “displaying the plurality of visual cue objects in thumbnails” as for example claim 17 recites; Koppolu et al. does not provide anything to teach or suggest creating an amended document “consistent with the specification, (*supra*),” which was missing from Livingston, to result in the present invention as recited in claims 1 or 9, much less claims 17 – 20 depending therefrom. Accordingly, since dependent claims include all of the differences with the references as the claims from which they depend, Koppolu et al. in combination with Livingston alone or further in combination with Simpson et al. does not result in the present invention as recited in claims 17 – 20. Reconsideration and withdrawal of the final rejection of claims 17 – 20 under 35 U.S.C. §103(a) over Koppolu et al. in combination with Livingston alone, or further in combination with Simpson et al., is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the

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amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the final rejection of claims 1 – 20 under 35 U.S.C. §§102(e), 103(a), 112 and allow the application to issue.

The applicants note that MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**. (emphasis added.)


The applicants believe that the written description of the present application is quite different than and not suggest by any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

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(Date)

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